

REMARKS**Summary of Telephone Interview**

A telephone interview was conducted on October 6, 2009 between Mark Svoboda of Delphi and Examiner McGraw. The substance of the interview was a general discussion of the rejection of Applicants' claim 1 against the Pataki et al. reference, including clarification of which elements in the cited reference were held to correspond to elements in Applicants' claim 1. No agreements were reached regarding specific amendments to claim language that would render the claims allowable. Applicants gratefully acknowledge the Examiner's assistance in identifying opportunities for improved communication in presenting arguments for allowability.

Claim Rejections under 35 USC §102

The Office Action rejects claims 1, 3, 5, 10, and 12 under 35 USC 102(b) as being anticipated by Pataki et al. (US 5,396,926). For the following reasons, reconsideration and withdrawal of these rejections are respectfully requested.

The Office Action identifies element (8) of Pataki as a source of high pressure fuel. Applicants respectfully disagree with this characterization. Pataki expressly states, "Valve passage **6** is a high pressure fluid supply passage and may be connected with a source of high pressure fuel for an internal combustion engine." (col 8 lines 58-60). Pataki also refers to valve passage (8) as an *outlet* passage (e.g. col 10 lines 3-4, col 10 line 26, col 11 line 65, etc.) The Examiner points to lines 9-13 of column 9 of Pataki to assert that Pataki's element (8) can be a high pressure fuel supply to a fuel injector. The cited passage relied upon by the Examiner states, "Valve passage 8 may be connected *to supply pressure to a load device*

such as a hydraulic cylinder, fuel injection nozzle or the like.” Applicants maintain that Pataki’s element (8) can only be act as a high pressure fuel supply to a fuel injector by virtue of the fact that it is the **outlet** of a control valve whose high pressure **source** is element (6).

Pataki teaches that the pressure at outlet passage (8) is controllable based on the position of the movable valve member 12. In col 11 line 58 through col 12 line 2, Pataki discloses that in the configuration illustrated in Fig. 1, fluid communication is sealed between high pressure supply passage (6) and outlet passage (8), and fluidic communication is permitted between first outer annular recess (40) (and hence, outlet passage 8) and drain passage (10). Thus, in the configuration illustrated in Fig. 1, the pressure at recess (40) is low, and there is no high pressure fuel available to a load connected to outlet passage (8).

Because Pataki expressly identifies element (6) as a high pressure fluid supply passage to the control valve and element (8) as the **outlet** of a control valve, and additionally teaches that element (8) can also be a **low** pressure source to an output load, Applicants submit that element (8) cannot be characterized as a high pressure source to the control valve arrangement.

Additionally, the Office Action first identifies element (40) in Pataki as the control chamber of Applicants’ claimed invention (last line of page 2). Later, the Examiner identifies element (41) in Pataki as the control chamber (page 3 lines 4, 5, and 10). Applicants respectfully submit that element (41) in Pataki is identified as “a second outer annular recess 41 in fluid communication with supply passage 6” (col 10 lines 15-16). As such, the pressure in (41) will be the supply pressure regardless of the position of the valve elements. Applicants’ claims 1 and 17 require in part a position of the control valve member in which the control chamber communicates with the low pressure fuel drain. Pataki does not teach a valve position in which element (41) communicates with the low pressure fuel drain (10), and

thus element (41) of Pataki cannot represent a control chamber as specified in Applicants' claims 1 and 17. As previously submitted in the remarks of Applicants' 2/28/2008 response, when Pataki's element (6) is correctly identified as a high pressure source and element (10) is identified as a low pressure drain passage, the control chamber in Pataki can only be interpreted as represented by the combination of Pataki's outlet passage (8) and annular recess (40).

Applicants' claims 1 and 17 recite in part a control valve member moveable to a second position wherein the control valve member engages a second seating such that the control chamber communicates with the low pressure fuel drain and communication between the control chamber and the source of high pressure fuel is broken. Pataki's position of valve member 12 that corresponds to Applicants' "second position" (i.e. the position in which the control chamber (40) communicates with the low pressure fuel drain (10) and communication between the control chamber (40) and the source of high pressure fuel (6) is broken) is the position illustrated in Pataki's Fig. 1. In Fig. 1 of Pataki, the seating that engages to break communication between the control chamber (40) and the source of high pressure fuel (6), corresponding to Applicants' "second seating", is the seating between surfaces (44) and (46). However, the Applicants' claims 1 and 17 also specify that the second seating is defined by a surface of a bore provided in a valve housing within which the control valve member is moveable. In contrast, Pataki recites, "Additionally, *formed in cavity 14 of the moveable valve member 12 is a valve seat 44* which cooperates with an upper surface 46 of the floating pin 16 in order to seal fluidic communication between an inner annular recess 48 formed in the moveable valve member 12 and the first outer annular recess 40 and consequently the outlet passage 8." (col 10 lines 20-26). Because Applicants' second seating is specified in claims 1 and 17 to be defined by a surface of a bore provided in a valve housing within which

the control valve member is moveable, it cannot be anticipated by Pataki's corresponding seating (44) defined internal to the valve member (12).

Applicants further submit that Pataki does not teach a restricted flow passage located between the first seating and the second seating and defined by an outer surface of the control valve member and the bore in the valve housing, as required by Applicants' claimed invention in claims 1 and 17. The only flow passage shown in Pataki that is located between the first seating (38) and the second seating (44) is the path through cavity (14), the parallel combination of two radial passages (42), and outer annular recess (40). Because this path is defined in part by cavity (14) and radial passages (42) that are defined *internal* to valve member (12), the only portion of the flow path defined by an *outer* surface of the control valve member and the bore in the valve housing (as required by Applicants' claims 1 and 17) is the outer annular recess (40). There is no teaching or suggestion in Pataki of outer annular recess (40) being a restricted flow passage. Therefore, Pataki does not anticipate the restricted flow passage as specified by Applicants' claims 1 and 17.

For at least the reasons cited above, Pataki does not anticipate the Applicants' claimed invention in independent claims 1 and 17. Applicants respectfully request the 35 USC 102(b) rejection of claim 1 be withdrawn and that claim 1 be allowed. For at least the reason that claims 3, 5, 10, and 12 depend from claim 1 which is believed to be in condition for allowance, Applicants respectfully request that the 35 USC 102(b) rejection of these claims also be withdrawn and that claims 3, 5, 10, and 12 be allowed.

Claim Rejections under 35 USC §103

In the December 5, 2008, Office action, the Examiner rejected claims 17 and 19 under 35 USC 103(a) as being unpatentable over Pataki in view of Harcombe (US 6,889,918). For the following reasons, reconsideration and withdrawal of these rejections are respectfully requested.

As discussed above, Applicants believe that claims 1 and 17 as previously presented overcome the Examiner's rejections under section 102 in regard to Pataki. Applicants also submit that the claims also distinguish over any combination of Pataki and Harcombe. As discussed fully above in regard to the Pataki reference, Pataki does not teach or suggest a restricted flow passage located between the first seating and the second seating and defined by an outer surface of the control valve member and the bore in the valve housing, as required by Applicants' claimed invention in claims 1 and 17. Applicants respectfully submit that Harcombe likewise does not teach or suggest a restricted flow passage as specified in Applicants' claims 1 and 17, and therefore does not overcome this deficiency in Pataki. For at least this reason, Applicants respectfully request reconsideration and withdrawal of the 35 USC 103(a) rejection of claim 17.

Regarding claim 19, Applicants respectfully submit that since Claim 19 includes all of the limitations of claim 1, claim 19 is also allowable. Applicants respectfully request reconsideration and withdrawal of the 35 USC 103(a) rejection of claim 19.

Double Patenting

A Terminal Disclaimer to disclaim the terminal part of the statutory term of any patent granted on the instant application which would extend beyond the expiration date of

US Patent no. 6,889,918 is being filed concurrent with this Response. Applicants respectfully submit that this Terminal Disclaimer obviates the non-statutory obviousness-type double patenting rejection, and request that the rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants request the withdrawal of the rejections to the claims. Reconsideration of the application and allowance of all pending claims is earnestly solicited. Accordingly, the Examiner is requested to reconsider and allow claims 1, 3, 5, 10, 12, 17, and 19 and to pass the case to issue.

Should the Examiner wish to discuss any of the above in greater detail or deem that further amendments should be made to improve the form of the claims, the Examiner is invited to contact the undersigned at the Examiner's convenience.

Please charge any necessary fees, including any extension of time, or any other fee deficiencies to Delphi Technologies, Inc., Deposit Account No. 50-0831.

Respectfully submitted,

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